

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Application of: Robyn R. Levine

Group Art Unit: 3622 : IBM Corporation
Examiner: Yehdega Retta : Intellectual Property Law
Serial No.: 09/761,121 : Department SHCB/040-3
Filed: 01/16/2001 : 1701 North Street
Confirmation No.: 2906 : Endicott, New York 13760
Title: BUSINESS OFFERING
CONTENT DELIVERY

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF UNDER 37 C.F.R. 41.37

Dear Sir:

Appellant hereby appeals from the Final Office Action of 10/25/2010 and offers the following arguments in support thereof:

(i) REAL PARTY IN INTEREST

The real party in interest is International Business Machines Corporation, a corporation of New York, with a place of business at Armonk, New York 10504.

(ii) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences with which the undersigned is aware.

(iii) STATUS OF CLAIMS

Claims 24 – 30 are pending in the present application. Claims 24 – 30 have all been finally rejected and are the subject matter of this appeal.

(iv) STATUS OF AMENDMENTS

No amendments were filed subsequent to the final rejection of 10/25/2010. Accordingly, claims 24 – 30 as presented in the amendment filed 09/09/2010 are being appealed and are listed in the "Claims Appendix" attached herewith.

(v) SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent Claim 24

By way of non-limiting example, the invention provides a system for creating and delivering an opportunity to a user. The system includes an access device having connectivity to a supplier advertising computer (page 8, lines 4 – 10, 18 – 19; page 2, lines 16 – 18). The access device also has a location indication capability (FIG. 1, 12; page 9, lines 15 – 26). The advertising computer executes instructions on a processor to provide a web site accessible by the user via the access device (claim 23 as originally filed; page 7, lines 13 – 19; FIG. 1, 18). The advertising computer also executes instructions to

determine constraints on the access device (page 10, lines 1 - 8). The advertising computer retrieves purchased lifestyle view data for the user from a firm (FIG. 1, 14; page 12, lines 1 - 9; claim 1 as originally filed). The advertising computer retrieves a profiled past of the user (FIG. 1, 14; FIG. 3, 14; page 10, lines 9 - 20). The advertising computer retrieves current actions of the user (FIG. 1, 16; FIG. 3, 16; page 12, line 17 - page 13, line 7).

The advertising computer also creates a vision of core competencies of the supplier based on the access device, and the profiled past, and the lifestyle view data, and the current actions (page 13, lines 8 - 11; page 14, lines 12 - 15). The advertising computer develops an opportunity consistent with this vision by merging the vision with the supplier's channel awareness (page 14, lines 15 - 19). The advertising computer delivers the opportunity to the user via the connectivity to the access device (page 13, lines 15 - 21).

(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

There is only one ground of rejection. Claims 24 - 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts (US 6,101,486) in view of Lee (US 6,829,475). However, the Examiner also makes citations to Nascenzi (US 6,879,960) in the Final Office Action.

(vii) ARGUMENT

Claims 24 - 30

The rejection of independent claim 24 and dependent claims

25 – 30 under 35 U.S.C. 103(a) is in error, and the decision to reject these claims should be reversed.

To establish a *prima facie* case of obviousness, all claim limitations must be taught or suggested by the prior art. See, *In re Roylea* 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974); see also, *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991). If the prior art references do not teach or suggest all of the claim limitations, Office personnel must explain why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art (MPEP 2141).

Claim 24 specifically requires retrieving purchased lifestyle view data, specifically for said user. The Examiner correctly states that Robert fails to teach purchasing lifestyle view data of any kind from a firm. However, the Examiner takes official notice that it is old and well known to acquire user's profile (lifestyle view) from a third party, and cites Nascenzi (U.S. 6,879,960) column 1, lines 20 – 57, column 6, line 8, to column 7, line 11, for support of the official notice. Applicant disagrees that Nascenzi describes her claim 24 requirement of retrieving purchased lifestyle view data specifically for said user.

The data described by Nascenzi is not specific for a particular user. Nascenzi describes geographic buying preferences. Nascenzi also describes neighborhood type and block group (the smallest geographic areas averaging about 300 households) data from a U.S. Census database. Clearly data for 300 households is not specific to a particular user. There is no description or suggestion in Nascenzi of Appellant's recited

lifestyle view data and no description or suggestion in Nascenzi of Appellant's lifestyle view data for a specific user. The Examiner has clearly erred in stating that Nascenzi teaches this.

Secondly, the Examiner states that the statement on page 12, lines 3 - 9 of Appellant's Specification, "Various firms provide data for purchase which is grouped or keyed to presenting a lifestyle or lifestage view of users by block or group or some baseline parameter. The purchased data presents a view of the user based on aggregation of data points, such as, but not limited to geographic block, age of head of household, income level, number of children, education, ethnicity and buying patterns." describes this feature of retrieving purchased lifestyle view data specifically for a particular user. The Examiner has erred. The two sentences in quotes above are describing data for blocks or groups of users and aggregation of data. There is no description or suggestion in these two sentences that retrieving purchased lifestyle view data from a firm for a single particular user, rather than groups of users, was known prior to Appellants filing date. Nor does Lee describe this.

Because of Examiner's errors noted above, a prima facie case of obviousness in view of the prior art for this requirement of claim 24 has not been made.

Claim 24 also requires creating a vision of core competencies of the supplier based on the access device, and the profiled past, and the lifestyle view data, and the current actions. The Examiner cites Roberts column 6 to column 7, line 10. There is no description or suggestion anywhere within

Roberts of creating a vision of core competencies much less one based on all four requirements of access device, profiled past, lifestyle view data and current actions as claim 24 requires. The Examiner has erred in stating that Roberts describes this. Nor does Lee describe or suggest this.

Claim 24 also requires merging the vision of core competencies with the supplier's channel awareness to develop an opportunity. The Examiner cites Roberts column 5, line 25, to column 6, line 11, specifically the portion about providing voice communication with the customer. However, there is no description or suggestion of merging anything in the citation. Again, the Examiner has erred in stating that Roberts describes this requirement of claim 24.

Appellant has shown above the manifest error in the Examiner's assertions in rejecting the independent claim 24. Accordingly, Appellant respectfully requests the Board reverse the rejection of claim 24 and return the application to the Examining Group for allowance.

Claims 25 - 30 depend directly or indirectly from independent claim 24 and are therefore also allowable over the cited art.

CONCLUSION

In view of the foregoing remarks, Appellant submits that claims 24 - 30 are patentably distinct from the prior art of record and are in condition for allowance. Accordingly, Appellant respectfully requests that the Board reverse the Examiner's rejection of claims 24 - 30 and remand the

application to the Examiner for allowance of the pending claims.

Respectfully submitted,

Dated: 02/18/2011 By: /John Pivnichny/

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(viii) CLAIMS APPENDIX

24. A system for creating and delivering an opportunity to a user, said system comprising:

an access device having connectivity to a supplier advertising computer and said access device having a location indication capability;

said advertising computer executing instructions on a processor to provide a web site accessible by said user via said access device, and additional instructions on said processor that when executed:

determine constraints for said access device;

retrieve purchased lifestyle view data for said user, from a firm;

retrieve a profiled past of said user;

retrieve current actions of said user;

create a vision of core competencies of said supplier based on said access device, and said profiled past, and said lifestyle view data, and said current actions;

develop an opportunity consistent with said vision by merging said vision of core competencies with said supplier's channel awareness; and

deliver said opportunity to said user via said connectivity

to said access device.

25. The system of claim 24, wherein said access device is a cell phone, kiosk, personal digital assistant such as a palm top device, a laptop computer, a desktop computer, or a computer terminal.

26. The system of claim 24, wherein said connectivity is a modem, digital modem, high speed lines, or wireless connection.

27. The system of claim 24, wherein said location indication capability is a real time GPS receiver.

28. The system of claim 24, wherein said profiled past includes a demographic profile.

29. The system of claim 24, wherein said current actions includes transactions.

30. The system of claim 29, wherein said transactions include listings of purchases or payment, or returns.

(ix) EVIDENCE APPENDIX

None.

(*) RELATED PROCEEDINGS APPENDIX

None.